

AMENDMENTS TO THE DRAWINGS

The attached sheets of drawings include changes to Figs. 1-18. Namely, labels have been added to unlabeled boxes.

Attachment: Replacement sheets

REMARKS

I. Status of the Application

Claims 38, 39, 41-50, and 64-105 were pending and were rejected. By way of this amendment, claims 38, 39, 41-45, 47-49, 64, 73-78, 81, 96-100, and 105 are amended. Additionally, claims 66, 102, and 103 are canceled, and new claim 106 is added. Thus, claims 38, 39, 41-50, 64, 65, 67-101, and 104-106 are now pending.

II. Formalities

A. Drawing Amendments

The Office Action objected to the Drawings and stated that the “drawings cannot consist solely of boxes and reference numbers ... [t]he boxes must be labeled as to what they are and/or redrawn to represent the real shape of the object they are intended to represent.” Office Action at p. 3.

In response to the rejection, Applicant submits herewith replacement drawings in which boxes have been labeled.

B. Claim Objections

The Office Action objected to claims 95 and 96 because there were two claims 96’s and no claim 95. The listing of claims provided herein renames the first claim “96” as claim “95”.

III. Rejection under 35 U.S.C. § 102(b)

Claims 38, 39, 41-46, 64, 65, 67-69, 71-76, 79-83, 90-94, 96-98, and 101-105 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,393,057 to Marnell, II (Marnell).

A. Claim 38

Claim 38 is generally directed to a method for facilitating play of a group game. Claim 38 has been amended and now recites “in each of a plurality of plays of individual games played by a plurality of players at respective gaming machines, generating an outcome

for the individual game, the outcome being one of a plurality of outcomes including at least a first group of outcomes and a second group of outcomes,” “displaying a first group of cells, each cell in the first group of cells capable of being designated with a designator in response to any player of the plurality of players achieving an outcome in the first group of outcomes, wherein the designator indicates the gaming machine at which the outcome in the first group of outcomes was generated,” and “designating a corresponding cell of the first group of cells with the designator responsive to an occurrence of any of the outcomes from the first group of outcomes.”

Additionally, claim 38 now recites “displaying a second group of cells while displaying the first group of cells, each cell in the second group of cells capable of being designated with the designator in response to any player of the plurality of players achieving an outcome in the second group of outcomes, wherein the designator indicates the gaming machine at which the outcome in the second group of outcomes was generated,” “designating a cell of the second group of cells with the designator responsive to an occurrence of any of the outcomes from the second group of outcomes,” and “wherein the first group of cells has associated therewith a first value payout and the second group of cells has associated therewith a second value payout different than the first value payout.”

Marnell describes numbered primary gaming devices, such as a poker gaming devices or a slot machines electronically linked to a bingo-type secondary gaming device. The secondary gaming device includes a display showing a bingo matrix. The bingo matrix is filled with indicia corresponding to game outcomes of the primary gaming devices. When a player at one of the primary gaming devices achieves a particular outcome, a number of the primary gaming device is displayed in the space in the bingo matrix corresponding to that outcome (i.e., the space is filled). In Marnell, once a BINGO is achieved an award is paid out.

Marnell does not teach that the bingo matrix displays a first group of cells while displaying a second group of cells, as now recited in claim 38, “wherein the first group of cells has associated therewith a first value payout and the second group of cells has associated therewith a second value payout different than the first value payout.” Rather, it appears that in Marnell only one value payout is associated with the bingo matrix.

Because Marnell does not teach, disclose, or suggest all the elements of amended claim 38, Applicant respectfully submits that claim 38 is allowable.

B. Claims 64 and 65

Claim 64 is generally directed to a group gaming method in which a group game includes taking steps toward a first group goal, and has been amended to specify that the steps are ordered. In particular, amended claim 64 now recites, *inter alia*, “displaying an image representative of a group game played by the plurality of players at the respective gaming machines, wherein the group game includes taking a first plurality of ordered steps toward a first group goal, wherein each step of the first plurality of ordered steps is attributable to any of the respective gaming machines of the plurality of player,” and “for each outcome from a first set of outcomes, displaying an image representative of taking one step of the first plurality of steps towards the first group goal, wherein the image representative of taking the one step of the first plurality of ordered steps towards the first group goal includes a designation indicative of the respective gaming machine at which the outcome from the first set of outcomes was determined.”

Amended claim 65 depends from claim 64 and now recites “wherein the image representative of the group game comprises a plurality of cells arranged in an order, wherein each cell of the plurality of cells corresponds to each step of the first plurality of ordered steps,” and “wherein displaying the image representative of taking one step of the first plurality of ordered steps towards the first group goal comprises designating a next cell in the order with the designation indicative of the respective gaming machine at which the outcome from the first set of outcomes was determined.”

Marnell describes a secondary gaming device including a display showing a bingo matrix. The bingo matrix is filled with indicia corresponding to game outcomes of the primary gaming devices. When a player at one of the primary gaming devices achieves a particular outcome, a number of the primary gaming device is displayed in the space in the bingo matrix corresponding to that outcome. When a row or column of the matrix is completed, a payout is awarded to a group of players.

The Office Action admitted that Marnell does not disclose designating cells in an order. But in rejecting claim 66, which generally related to arranging cells in an order and

designating cells in the order, the Office Action alleged that claim 66 was rendered obvious over Marnell in view of the Pathfinder document (Pathfinder) which describes a game on a television game show. It appears that the Office Action alleges that Pathfinder suggests modifying Marnell such that the cells of bingo matrix in Marnell can only be designated in an order.

As described above, Marnell describes a group bingo game in which the object is to complete a row or column of a bingo matrix. A cell of the bingo matrix is filled when a primary gaming device achieves an outcome of the primary game that corresponds to the bingo matrix cell. For example, if a player on a primary gaming device achieves a three-of-a-kind during a poker game, a cell in the bingo matrix corresponding to a three-of-a-kind outcome is filled. Marnell does not suggest that the cells of the matrix are ordered in some way and/or must be filled in a particular order.

Pathfinder describes a game having a five-by-five matrix of numbers. The digits of the price of a car are included in the matrix of numbers but the player does not know which of the numbers are the car price digits. The car price digits extend from the center of the matrix as a sequence of adjacent cells. A player, starting in the center square, must guess the first digit in a cell adjacent to the center square. If the player guesses correctly, the player moves to the cell having the first digit and must guess the next digit in an adjacent cell. If the player guesses correctly, the player may move onto that cell and the game continues. If the player guesses incorrectly, the player must move back to the previous cell and then guess the price of one of three small items. If the player correctly guesses the price of one of the three small items, the player may then take another guess at the next digit in the matrix.

Unlike the Marnell group game, the Pathfinder game is not a bingo-type game or even a group game. For example, the object in the Pathfinder game is not to complete a known pattern in a matrix (e.g., a row or a column). Rather, it is to guess an unknown sequence of numbers included in the matrix. The pattern of spaces in Pathfinder is purposely concealed from the player. Further, spaces in the Pathfinder matrix do not correspond to game outcomes and are not filled when the corresponding game outcome is achieved. Rather, a space is filled when a player chooses the space and the space is one of the car price digits. Moreover, it appears that only one person plays the Pathfinder game, thus it is not a group

game. It appears that the only thing in common between Marnell and Pathfinder is that they both involve a game utilizing a matrix.

Because the games of Marnell and Pathfinder are so different, Marnell cannot be said to provide a suggestion to make the modification proposed by the Examiner. Marnell describes a bingo-type game. Pathfinder, on the other hand, describes an entirely different type of game with a different goal and a different method of filling cells. In Marnell, a cell in a matrix is filled when a particular outcome of a base game are achieved, whereas in Pathfinder, a cell in a matrix is filled when a player chooses that cell. There is nothing in Marnell or Pathfinder that suggests that their teachings be combined as suggested by the Examiner.

A proper obviousness rejection must identify a suggestion or motivation to make the specific modification it proposes. *See In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (“[T]o establish obviousness ... there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.”) (emphasis added). Here, the Office Action does not allege that Marnell, Pathfinder, any other reference, or even the knowledge of persons of ordinary skill in the art provides a motivation or suggestion to make the specific modification it proposes, namely to modify the rules of Marnell’s bingo-type game to require that cells in a matrix can only be filled in some particular order. Rather, the Office Action merely lists general advantages provided by the proposed modification (e.g., “[t]he more difficult it is to achieve a ‘bingo’ the less that the player’s will win and the more money the casino will make”). This is not evidence of a motivation or suggestion in the art to make the specific modification proposed by the Office Action. On the contrary, the listed advantages are at most general goals (e.g., increase enjoyment of game, increase profits for casino, etc.) that do not establish a *prima facie* case of obviousness.

Accordingly, Applicant respectfully submits that amended claims 64 and 65 are not disclosed, taught, or suggested by the applied references. Reconsideration is respectfully requested.

C. Claim 81

Independent claim 81 has been amended and now is generally directed to a group gaming method in which an image representative of a group game comprises cells corresponding to a first group goal and a second group goal. Claim 81 now recites displaying an image representative of a group game played by the plurality of players at the respective gaming machines, wherein the image representative of the group game comprises a first plurality of cells corresponding to a first group goal and a second plurality of cells corresponding to a second group goal, wherein each cell of the first plurality of cells and the second plurality of cells is attributable to any of the respective gaming machines of the plurality of players,” and “for each outcome from a first set of outcomes, designating a cell of the first plurality of cells with a designation indicative of the respective gaming machine at which the outcome from the first set of outcomes was determine.” Additionally, claim 81 now recites “for each outcome from a second set of outcomes, designating a cell of the second plurality of cells with a designation indicative of the respective gaming machine at which the outcome from the second set of outcomes was determined,” “providing a first value payout if the first group goal is achieved,” and “providing a second value payout different from the first value payout if the second group goal is achieved.”

Marnell does not describe “displaying an image representative of a group game played by the plurality of players at the respective gaming machines, wherein the image representative of the group game comprises a first plurality of cells corresponding to a first group goal and a second plurality of cells corresponding to a second group goal,” “providing a first value payout if the first group goal is achieved,” and “providing a second value payout different from the first value payout if the second group goal is achieved.” Rather, it appears that in Marnell only one value payout is associated with the bingo matrix.

Because Marnell does not teach, disclose, or suggest all the elements of claim 81, Applicant respectfully submits that claim 81 is allowable.

D. Claims 68 and 92

Claim 68 depends from claim 64. It is respectfully submitted that claim 68 is allowable at least for the same reasons as claim 64, and for additional reasons.

Claim 92 depends from claim 81. It is respectfully submitted that claim 92 is allowable at least for the same reasons as claim 81, and for additional reasons.

With respect to claim 68, it recites “wherein designating the cell of the plurality of cells comprises removing a previous designation, if any.” Similarly, claim 92 recites “wherein designating the cell of the first plurality of cells comprises removing a previous designation, if any.”

The Office Action alleged that Marnell discloses the elements recited in claims 68 and 92. Applicant respectfully traverses this assertion. But Marnell describes that once a cell has been attributed to a primary gaming device it cannot be attributed to another gaming device. *See Marnell* at col. 10, lines 53-64. The Office Action asserts that, nonetheless, Marnell discloses these elements because Marnell describes removing all entries in the bingo matrix after a time period, removing entries corresponding to a particular gaming device after a time period in which games are not played at the gaming device, and removing entries in response to a player choosing to remove entries corresponding to the player’s gaming device. *See Marnell* at col. 10, lines 24-49. But the removal of bingo matrix entries described in Marnell is not at all related to filling a cell with a new entry. Rather, in Marnell, removing bingo matrix entries is entirely disconnected from filling bingo matrix cells. Thus, Marnell does not describe designating a cell as recited in claim 64 “wherein designating the cell of the plurality of cells comprises removing a previous designation, if any.”

Accordingly, Marnell does not disclose the element recited in claim 68. At least for this additional reason, claim 68 is allowable.

For similar reasons, Marnell does not disclose the element recited in claim 92. At least for this additional reason, claim 92 is allowable.

E. Claim 74

Claim 74 depends from claim 64. It is respectfully submitted that claim 74 is allowable at least for the same reasons as claim 64, and for additional reasons.

Claim 74 recites “wherein the first group goal has associated therewith a first value payout, and wherein the second group goal has associated therewith a second value payout different than the first value payout.” As discussed above with respect to claim 38, Marnell

describes only one value payout associated with the bingo matrix. At least for this additional reason, it is respectfully submitted that claim 74 is allowable.

F. Other Claims Rejected under 35 U.S.C. §102(b)

It is respectfully submitted that claim 105, as amended, is allowable at least for reasons similar to those discussed above with respect to claim 64, and for additional reasons.

It is respectfully submitted that new claim 106 is allowable at least for reasons similar to those discussed above with respect to claim 38, and for additional reasons.

Claims 39 and 41-46 depend from claim 38. Applicant respectfully submits that these claims are allowable at least for the same reasons as discussed above with respect to claim 38, and for further reasons.

Claims 67, 69, 71-73, 75, 76, 79, and 80 depend from claim 64. It is respectfully submitted that these claims are allowable at least for the same reasons as discussed above with respect to claim 64, and for additional reasons.

Claims 82, 83, 90, 91, 93, 94, 96-98, 101, and 104 depend from claim 81. Applicant respectfully submits that these claims are allowable at least for the same reasons as discussed above with respect to claim 81, and for additional reasons.

Claims 102 and 103 are canceled.

III. Rejections under 35 U.S.C. § 103

Claims 70, 77, 78, 95, 99, and 100 were rejected under 35 U.S.C. § 103 as being unpatentable over Marnell. Claims 47-50 were rejected under 35 U.S.C. § 103 as being unpatentable over Marnell in view of U.S. Patent No. 3,618,952 to Tallarida (Tallarida). Claims 66 and 84-89 were rejected under 35 U.S.C. § 103 as being unpatentable over Marnell in view of Pathfinder.

A. Claims 47-50

Claims 47-50 depends from claim 38. The Office Action alleged that Marnell discloses all the elements of claim 38 and that Tallarida discloses the remaining elements recited in claims 47-50.

But as discussed above, Marnell does not teach, disclose, or suggest all the elements of claim 38. Further, Tallarida does not teach, disclose, or suggest the elements of claim 38 that Marnell fails to teach, disclose or suggest. Accordingly, Applicant respectfully submits that claims 47-50 are allowable at least for this reason, and for additional reasons.

B. Claim 66

Claim 66 is canceled.

C. Claims 70, 77, 78, 99, 100

Claims 70, 77, and 78 depend from claim 64. As discussed above, Marnell does not teach, disclose, or suggest all of the elements of claim 64. At least for this reason, claims 70, 77, and 78 are allowable.

Claims 99 and 100 depend from claim 81. As discussed above, Marnell does not teach, disclose, or suggest all of the elements of claim 81. At least for this reason, claims 99 and 100 are allowable.

Claims 70, 77, 78, 99, and 100 all generally relate to designating a cell of a group game with multiple designations, attributing a step to multiple players, or attributing a step to one player multiple times.

Marnell describes numbered primary gaming devices, such as a poker gaming devices or a slot machines electronically linked to a bingo-type secondary gaming device. The secondary gaming device includes a display showing a bingo matrix. The bingo matrix is filled with indicia corresponding to game outcomes of the primary gaming devices. When a player at one of the primary gaming devices achieves a particular outcome, a number of the primary gaming device is displayed in the space in the bingo matrix corresponding to that outcome. But if that space in the bingo matrix is already filled due to a previous entry by the player or some other player, entry of the gaming device number into the space is denied. *See Marnell* at col. 10, lines 53-64.

In rejecting claims 70, 77, 78, 99, and 100, the Office Action alleged that it would have been obvious to modify the gaming system of Marnell to permit a space of the bingo matrix to be designated to multiple gaming devices or to a single player multiple times. The Office Action did not, however, point to any suggestion or motivation in the art to make this modification. Rather, the Office Action appears to list advantages of the claimed invention

and then argue that these advantages would motivate one of ordinary skill to make the modification. This is impermissible hindsight reasoning using knowledge gleaned from Applicant's own disclosure. *See M.P.E.P.*, Section 2143.

A proper obviousness rejection must identify a suggestion or motivation to make the specific modification it proposes. *See In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) ("[T]o establish obviousness ... there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.") (emphasis added). Here, the Office Action does not allege that Marnell, any other reference, or even the knowledge of persons of ordinary skill in the art provides a motivation or suggestion to make the specific modification it proposes, namely to modify the system of Marnell such that a cell of Marnell's bingo matrix may be designated to multiple gaming devices or designated to a single gaming device multiple times. Rather, the Office Action merely lists general advantages (e.g., "the game becomes more enjoyable to players") provided by the proposed modification. This is not evidence of a motivation or suggestion in the art to make the specific modification proposed by the Office Action. On the contrary, it is merely hindsight recognition of advantages of Applicant's claimed invention. And even if the allegations of the Office Action are not impermissible hindsight, the advantages it lists are general goals (e.g., increase enjoyment of game) that do not establish a *prima facie* case of obviousness.

Accordingly, Applicant respectfully submits that claims 70, 77, 78, 99, and 100 are not disclosed, taught, or suggested by Marnell.

D. Claims 84-89

Claim 84-89 depend from claim 81. The Office Action alleged that Marnell discloses all the elements of claim 81 and that Pathfinder discloses the remaining elements recited in claims 84-89.

But as discussed above, Marnell does not teach, disclose, or suggest all the elements of claim 81. Further, Pathfinder does not teach, disclose, or suggest the elements of claim 81 that Marnell fails to teach, disclose or suggest. Accordingly, Applicant respectfully submits that claims 84-89 are allowable at least for this reason.

With respect to claim 84, it recites “wherein the first plurality of cells is arranged in an order” and “wherein designating the cell of the first plurality of cells comprises designating a next cell in the order.” The Office Action alleged that claim 84 is obvious over Marnell in view of Pathfinder. But as discussed above with respect to claim 64, the games of Marnell and Pathfinder are so different that Pathfinder cannot be said to provide a suggestion to make the modification of Marnell proposed by the Examiner. Marnell describes a bingo-type game. Pathfinder, on the other hand, describes an entirely different type of game with a different goal and a different method of filling cells. In Marnell, a cell in a matrix is filled when a particular outcome of a base game are achieved, whereas in Pathfinder, a cell in a matrix is filled when a player chooses that cell. There is nothing in Marnell or Pathfinder that suggests that their teachings be combined.

A proper obviousness rejection must identify a suggestion or motivation to make the specific modification it proposes. *See In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (“[T]o establish obviousness … there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.”) (emphasis added). Here, the Office Action does not allege that Marnell, Pathfinder, any other reference, or even the knowledge of persons of ordinary skill in the art provides a motivation or suggestion to make the specific modification it proposes, namely to modify the rules of Marnell’s bingo-type game to require that cells in a matrix can only be filled in some particular order. Rather, the Office Action merely lists general advantages provided by the proposed modification (e.g., “[t]he more difficult it is to achieve a ‘bingo’ the less that the player’s will win and the more money the casino will make”). This is not evidence of a motivation or suggestion in the art to make the specific modification proposed by the Office Action. On the contrary, the listed advantages are at most general goals (e.g., increase enjoyment of game, increase profits for casino, etc.) that fail to establish a *prima facie* case of obviousness.

At least for this additional reason, claim 84 is allowable.

Claims 85-89 depend from claim 84. At least for the reasons discussed above with respect to claim 84, claims 85-89 are allowable.

With respect to claim 85 in particular, it recites “wherein the image representative of the group game includes a ladder, the ladder comprising the first plurality of cells, the ladder

having a bottom and a top," and "wherein designating the cell from the first plurality of cells comprises designating the next undesignated cell from the bottom of the ladder."

The Office Action alleged that Pathfinder discloses this element. Pathfinder describes a matrix of numbers on a floor. It cannot be said that providing a matrix of numbers on a floor is displaying an image representative of a group game "wherein the image representative of the group game includes a ladder, the ladder comprising the first plurality of cells, the ladder having a bottom and a top," and "wherein designating the cell from the first plurality of cells comprises designating the next undesignated cell from the bottom of the ladder," as recited by claim 85. The Pathfinder document never uses the word ladder. The Pathfinder matrix of numbers is on a floor, it is all on one level, and does not have a bottom and a top. Further, the sequence of squares in Pathfinder corresponding to the car price digits is not even a straight line because the matrix is a 5-by-5 matrix, the contestant starts in the center square, and the sequence is four squares long. Clearly, the matrix of numbers in Pathfinder cannot not be said to be an image representative of a group game including a ladder, as recited in claim 85.

At least for this additional reason, claim 85 is allowable.

Claim 86 depends from claim 85. At least for the same reasons discussed above with respect to claim 85, claim 86 is allowable. Additionally, claim 86 recites "if the next undesignated cell is designated, displaying an image of a figure on the ladder moving toward the top by one cell."

The Office Action alleged that this element is disclosed by Pathfinder because Pathfinder discloses that a person moves from square to square in the matrix. But as discussed above, the matrix in Pathfinder does not have a top and a bottom and in fact is placed on a floor. It cannot be said that Pathfinder discloses the element recited in claim 86. At least for this additional reason, claim 86 is allowable.

Claim 87 recites "wherein the image representative of the group game includes a lane, the lane comprising the first plurality of cells, the lane having a beginning and an end," and "wherein designating the cell from the first plurality of cells comprises designating the next undesignated cell from the beginning of the lane." The Office Action alleged that Pathfinder discloses this element. Pathfinder describes a matrix of numbers. It cannot be said that

providing a matrix of numbers is displaying an image representative of a group game “wherein the image representative of the group game includes a lane, the lane comprising the first plurality of cells, the lane having a beginning and an end,” and “wherein designating the cell from the first plurality of cells comprises designating the next undesignated cell from the beginning of the lane,” as recited by claim 87. The Pathfinder document never uses the word lane. Additionally, the sequence of squares in Pathfinder corresponding to the car price digits is unknown to the player, and the player must guess where it is. Clearly, the matrix of numbers in Pathfinder cannot not be said to be an image representative of a group game including a lane, as recited in claim 87.

At least for this additional reason, claim 87 is allowable.

Claims 88 and 89 depend from claim 87. At least for the same reasons discussed above with respect to claim 87, claims 88 and 89 are allowable.

E. Claim 95

Claim 95 depends from claim 81. The Office Action alleged that Marnell discloses all the elements of claim 81 and that the remaining elements recited in claim 95 are rendered obvious over Marnell.

But as discussed above, Marnell does not teach, disclose, or suggest all the elements of claim 81. Accordingly, Applicant respectfully submits that claim 95 is allowable at least for this reason, and for additional reasons.

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Amendment dated October 27, 2005
Reply to Office Action of July 28, 2005

Docket No.: 29757/AG42

V. Conclusion

In view of the above amendment and remarks, Applicant believes the pending application is in condition for allowance. Reconsideration is respectfully requested.

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Respectfully submitted,

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REPLACEMENT SHEETS